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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,164

Applicant(s)

WHITTLESEY ET AL.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/1/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-28 in the reply filed on June 26, 2006 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by DiBenedetto et al. 2004/0177531 A1 (DiBenedetto '531). DiBenedetto '531 discloses all the limitations of the claims including the following: (see especially Figures 1, 2A, 7 and 8) an upper 102; at least one active-response element 124, 126; a sole 104 coupled to the upper to define a chamber for receiving a wearer's foot; at least one sensor 122; a controller 120 operatively connected to said sensor and said active-response element; said controller determines whether the wearer is walking or swinging and when the wearer is swinging (see page 4, first column, end of paragraph [0051], also paragraphs [0057], [0067]), said controller sends an output current to said active-response element and said active-response element changes said shoe from an initial state (no added air pressure) where the shoe exhibits a first set of characteristics to a transitory state (air either added or released) where the shoe exhibits a second set of characteristics different from said first set of characteristics; said output current is sent to said sensor, and said sensor sends said output current to said active-response element (see references to 130 and it's subparts in paragraphs [0052], [0053], [0058], as well as reference to 330 in paragraphs [0059] etc.); said active-response element comprises a sole adjuster (adjusts the compressibility of the midsole, se

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paragraph [0057]); said controller sends said output current if said sensor senses a pressure greater than a preset swing threshold within a preset time interval threshold ([0060], [0070], [0071]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being obvious over DiBenedetto et al.

2004/0177531 A1 (DiBenedetto '531) as applied above. (DiBenedetto '531) discloses all the limitations substantially as claimed including the shoe being more stable in a first set of characteristics when walking, i.e. planting foot on ground, than in the second when swinging, i.e. the upswing of the user's pace (first when no change is made, second when changes are made. When changes are made, the shoe becomes more unstable as it is changing the natural stance/feel of the shoe to the user), Energy is generated (by compression) and outputted on lift-off, the user's foot is less movable in the shoe during second characteristics (inflating/expanding the expansion element compresses the foot against the upper of the shoe more than when it is not inflated/expanded), except for the specific pressures and times. The control system of (DiBenedetto '531) adjusts pressure and time of enacting the change of pressure based upon the pace of the user. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to adjust the expansion at any given time frame and pressure based upon the individual needs of the user inputted through the input device.

6. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DiBenedetto '531) as applied above in view of Mott 5,500,635. (DiBenedetto '531) as applied above discloses all the limitations substantially as claimed except for the multiple sensors and their locations. Mott '635 teaches

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that a single sensor 218 can be replaced by multiple sensors 518 that are spaced apart and located under the fourth metatarsal bone head and another metatarsal bone head (see Figure 7) and sense peak pressure of the user's foot throughout the gait cycle to aid in returning information to an adjustor that can adjust the support in those areas of the sole to make the shoe comfortable for the user. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place multiple sensors in the areas of the foot that receive the most impact during use of the shoe of (DiBenedetto '531) to better able the adjustment of the support for the user based upon the pressures sensed in these high areas.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.


8. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Anthony Stashick
Primary Examiner
Art Unit 3728

ADS